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10/080,571	02/25/2002	Edwin H. Adams	ADAE-002	8652
7590	10/31/2005			
Howard N. Flaxman Suite 112 2341 Jefferson Davis Hwy. Arlington, VA 22202			EXAMINER HOTALING, JOHN M	
			ART UNIT	PAPER NUMBER
			3714	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/080,571  
Filing Date: February 25, 2002  
Appellant(s): ADAMS, EDWIN H.

**MAILED**

**OCT 31 2005**

**Group 3700**

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Howard N. Flaxman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 5/11/05 appealing from the Office action  
mailed 2/16/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 5/11/05 to correct the drawings has been entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2002/0082775	MEADOWS	6-2002
5,859,628	ROSS et al	1-1999

### **(9) Grounds of Rejection**

The following ground(s) of rejection are reproduced herein for the convenience of the board and applicable to the appealed claims:

Claims 1, 3-5, 7, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meadows et al Patent Application Publication 2002/0082775 in view of Ross et al US Patent 5,859,628. Meadows discloses all of the instant application but does not specifically limit the points of data that a user can download into a GPS enabled PDA to the front of the hole greens and the middle of the Hole greens or specifically state the use of a cradle with memory. Meadows does disclose in figures 18-24 that the player can have a measurement to the middle and front of the hole greens along with other measurements (see also paragraphs 42-45). Meadows discloses multiple points that could be entered and viewed with relation to ball distance. With respect to having the data of the front and the middle of the hole greens it would be an obvious matter of choice well within the capabilities of one skilled in the art to choose measurement points and only include player or system desired points since the structure for doing so is known and taught in Meadows. With respect to the survey of the golf course by the player or anybody else please see paragraphs 49-51. With respect to data exchange please see paragraphs 189-191 where it is taught that information is wirelessly beamed to the PDA. It is well known that data and programs

can be transferred to and from a PDA by the use of a cradle and as disclosed above wirelessly. This is also motivation to search for and find a specific cradle structure that contains a memory. In an analogous invention to Ross therein is disclosed a service providing method of transferring information from a cradle with a memory to a PDA where the information transferred offers a service to the user. In this case Column 6 lines 44-67 discloses that the preferred embodiment of the present invention is to provide predetermined data relating to services available at locations along a highway. Column 8 discloses an intelligent cradle. Regarding the selling of the golf course information to patrons in order to provide them with a service is inherent to the use of the information. The information could be provided free while being disguised as part of the fees for using the golf course or as membership dues to a country club. It would be obvious to one of ordinary skill in the art at the time of the invention to have a wireless PDA with golf points of interest thereon provided to a user by a PDA cradle with a memory that contains the points of interest. One would be motivated to find combine a cradle with a PDA in order to transfer information to and/or from the PDA.

#### **(10) Response to Argument**

The appellant's arguments can be summed up in that appellant states that the examiner did not establish a prima facie case of obviousness, did not find a cradle with a memory that only stores reference points of the front and middle of a hole green, did not provide a motivation to combine the two references, and that it is not obvious to strip down the system of Meadows in order to arrive at the appellant's claimed invention.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

In the instant case the suggestion or motivation to combine or find a cradle with a memory comes from what is well known in the art with respect to personal digital assistants (PDA's) which is that they are capable of being put in a cradle where information can be transmitted to and from the PDA. One of ordinary skill in the art would expect that a PDA would be able to transfer information using the well known

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structure of a cradle thus a reasonable expectation of success and a motivation to find a cradle with a memory. The examiner states that the combination of Meadows with Ross teaches all of the claimed limitations as further explained below.

Paragraph 45 specifically states that the golfer can also load course object data previously surveyed by the golfer **or others** and adjust the distance processing to correct for environmental conditions. Paragraph 56 discloses that it is known to use a system that was previously surveyed by the golfer and/or downloaded via PC, landline, or wireless link into the system. This teaches that it is known to download information but does not specifically mention a cradle. Paragraph 78 states that reference points can be pre-surveyed in the tee area of each hole and other specific points along the hole to allow the golfer to establish new eFilter correction values at each hole. These specific reference points can be grouped as non-target points (SmartMarks) and displayed in a list for each hole to enable the golfer to easily find the nearest reference point where he can adjust for new environmental and other conditions that introduce errors in the position solution. These paragraphs disclose that the object data can be surveyed by a third party for use by a golfer and transferred from a computer system to a PDA that has GPS in it for use on a golf course. With respect to what data is to be stored in the information to be downloaded to a PDA the examiner has previously stated that the compilation of points to be displayed would be an obvious matter of choice well within the capabilities of one skilled in the art. If desired, the system operator may only enter the front and the middle of the hole greens to be a reference point of interest. Since the data transferred to the PDA is a file or plurality of files the information listed

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therein is only limited by the person or third party entering the information. The system of Meadows is able to collect all selected data points by a third party, once this is done these data points do not have to be updated again and it is simply a matter of downloading or transmitting the information to a users PDA which is a file or plurality of files. With respect to the expense of inputting multiple points of interest instead of only the front and middle of the hole green the combination of Meadow with Ross teach a system that is capable of only inputting the front and middle of hole greens by a third party for use by downloading the points of interest into a users PDA. This is done using the cradle with a memory as disclosed by Ross with the motivation of what is well known in the art of using a cradle with a PDA and that Meadows teaches the transfer of information. The examiner does not consider this to be a Meadows "striped down" version since the system of Meadows is capable of delivering only selected point collected by a third party for use in a PDA. With respect to the use of the Ross reference in that Ross is not related to golf in any way the examiner cited Ross to teach what is well known with respect to PDA's and the transfer of information. Ross is not cited to teach any golf implementation. Ross is cited by the examiner to teach the use of a cradle system with a memory that transfers desired and purchased information to a user PDA which contains points of interest for use with a PDA and GPS services.

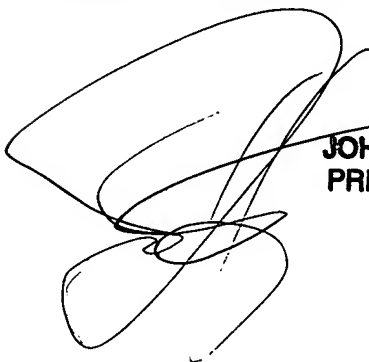


**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**

Conferees:

Cheryl Tyler

Scott Jones

